

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed February 24, 2004. In order to advance prosecution of this case, Applicant amends Claims 1, 39, 77, 101, 128, and 155. The amendments are not made as the result of any prior art reference and do not narrow the scope of any of the claims. Furthermore, the amendments are not related to patentability issues and only further clarify subject matter already presented. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Section 101 Rejections

The Examiner rejects Claims 1-38, 77-127, and 155-168 under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Although Applicant believes Claims 1-38, 77-127, and 155-168 to be allowable subject matter as written, Applicant has made clarifying amendments to Claims 1-38, 77-127, and 155-168 in order to address the Examiner's concern. Additionally, Applicant reminds the Examiner of the standards and laws associated with this issue. Patentable subject matter is clearly defined as "any new and useful process, machine, manufacture or composition of matter, or any new and useful improvement thereto."<sup>1</sup> When an abstract idea is reduced to a practical application, the abstract idea no longer stands alone if the practical application of the abstract idea produces a useful, concrete, and tangible result. This then satisfies the requirements of 35 U.S.C. §101.<sup>2</sup> While an abstract idea by itself may not satisfy the requirements of 35 U.S.C. §101, an abstract idea when practically applied to produce a useful, concrete, and tangible result satisfies 35 U.S.C. §101.<sup>3</sup> Thus, producing a useful, concrete, and tangible result is the key to patentability according to *State Street* and other applicable case law.

Claims 1-38, 77-127, and 155-168 produce a useful, concrete, and tangible result and, therefore, are in full accordance with jurisprudence germane to this subject matter. Only in cases where a claim is devoid of any limitation to a practical application in the technological

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<sup>1</sup> See 35 U.S.C. §101.

<sup>2</sup> See *In re Alappat*, 33 F.3d 1526, 31 U.S.P.Q. 2d 1545, 1558 (Fed. Cir. 1994); see also *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 47 U.S.P.Q. 2d 1596, 1601-02 (Fed. Cir. 1998).

<sup>3</sup> See *AT&T Corp. v. Excel Comm. Inc.*, 172 F.3d 1352, 1357, 50 U.S.P.Q. 1447, 1452 (Fed. Cir. 1999) (stating that as technology progressed, the CCPA overturned some of the earlier limiting principles regarding §101 and announced more expansive principles formulated with computer technology in mind); see also *In re Musgrave*, 431 F.2d 882, 167 U.S.P.Q. 280 (CCPA 1970) (cited by the Federal Circuit in *AT&T Corp.*, 172 F.3d at 1356).

arts should it be rejected under 35 U.S.C. §101.<sup>4</sup> Thus, the Examiner's contention is mistaken, as Claims 1-38, 77-127, and 155-168 are not merely "directed to abstract ideas and, therefore, non-statutory subject matter."<sup>5</sup> Instead, Claims 1-38, 77-127, and 155-168 are directed to various methods of routing an object in a transportation network that include a number of limitations, which are clearly within the scope of patentable subject matter as defined by 35 U.S.C. §101. Routing an object in a transportation network provides one of a myriad of practical applications of Claims 1-38, 77-127, and 155-168. Therefore, the rejection of Claims 1-38, 77-127, and 155-168 under 35 U.S.C. §101 is improper and, accordingly, Applicant respectfully requests written notice to this effect.

#### Section 112 Rejections

The Examiner rejects Claims 39-100 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Although Applicant believes Claims 39-100 to be proper as written, Applicant has made clarifying amendments to Claims 39-100 in order to address the Examiner's concern. Thus, Claims 39-100 should now be allowable and notice to this effect is respectfully requested.

#### Allowable Subject Matter

Applicant notes with appreciation the Examiner's allowance of Claims 128-154. Applicant reserves the right to comment on the reasons for the allowance of these claims at a future time should Applicant deem it appropriate to do so.

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<sup>4</sup> See M.P.E.P. §2106.

<sup>5</sup> See Previous Office Action.

CONCLUSION

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all pending Claims. If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicant stands ready to conduct such a conference at the convenience of the Examiner.

Applicant believes no fees are due. If this is not correct, the Commissioner is hereby authorized to charge additional fees or credit any overpayments to Deposit Account No. 02-0384 of Baker & Botts, L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact its attorney at the number provided below.

Respectfully submitted,  
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